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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,711	12/05/2003	Rick L. Murphy	03-40219-US-C	4226

7066 7590 01/13/2005

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EXAMINER

CHENG, JOE H

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/729,711	Applicant(s) MURPHY, RICK L.	
	Examiner Joe H. Cheng	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2004 and 21 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-15 and 17-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7,8,10-15,17-19 and 21-38 is/are rejected.
- 7) ☒ Claim(s) 6 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In response to the Amendment filed on August 6, 2004 and August 21, 2004, claims 2, 9 and 16 have been cancelled, and claims 1, 3-8, 10-15 and 17-21 and the newly added claims 22-8 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 7, 8, 10-13, 15, 21, 22, 26-31, 33-35 and 38 are rejected under 35 U.S.C. § 102(b) as being anticipated by Cook et al (U.S. Pat. No. 5,727,950). Cook et al discloses a computerized method for providing educational service to at least one user (student 101 in Fig. 1) engaging in at least one activity (see column 10, lines 59 and 60). The activity is automatically monitored by an agent (108), which acts as a virtual tutor for the student (see column 12, lines 20-23 and 46-47). The agent is an on-screen icon which “instruct, motivates, engages and guides its student” (see column 6, lines 3-4). The agent automatically and temporarily interrupts the engaging in the activity depending upon the detecting (see column 13, lines 33-36). (A “meta response” is a response sent directly to the agent from the student (see column 13, lines 10-17)). While Cook et al does not explicitly state that the interruption is temporary, it is submitted that it is because the function of a tutor or guide is to interrupt a student temporarily to provide guidance or help with a problem and then allow the student to resume the activity. Additionally, the interaction between the agent and the student is clearly associated with educational activities,

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as required by the last limitation in claim 1. Further, Cook et al also provides the claimed system and computer program product as claimed in claims 7 and 15 (note Section 5.2 beginning in column 19).

Claim Rejections - 35 USC §103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 3, 5, 14, 17, 19, 23-25, 32, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al (U.S. Pat. No. 5,727,950) in view of LoSasso et al (U.S. Pub. No. 2003/0008266 A1). It is noted that the teaching of Cook et al does not specifically disclose the at least one activity comprises at least one of operating a software application, surfing the web, participating with instant messaging (as per claims 3, 17 and 23), retrieving data from at least one remote database by using a Uniform Resource Locator address (as per claims 5, 19, 24 and 36), or generating at least one Hyper Text Transfer Protocol request (as per claims 6, 25 and 37) as required. However, the teaching of LoSasso et al broadly discloses the automatically

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presenting educational services to at least one user by the agent during the interrupted, retrieving data from at least one remote database by using a Uniform Resource Locator address, or generating at least one Hyper Text Transfer Protocol request (see Figs. 1-21). Hence, it would have been obvious to one of ordinary skill in the art to modify the method and system of Cook et al with the features of the at least one activity comprises at least one of operating a software application, surfing the web, participating with instant messaging, using a Uniform Resource Locator address to retrieve data, or generating Hyper Text Transfer Protocol request as taught by LoSasso et al as both Cook et al and LoSasso et al are directed to the method and system for providing educational services to at least one user engaging in at least one activity, so as to provide the educational services during the interrupting and retrieving data through the internet. It is also noted that the teachings of Cook et al and LoSasso et al do not explicitly disclose the communications device is a telephone (as per claims 14 and 32) as required. However, such feature of using the telephone as the communications device is old and well known, and is considered an arbitrary obvious design choice, so as to use the telephone of the communications devices for providing educational service.

Double Patenting

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and

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useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claims 1, 4, 15, 18, 22 and 34 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 3 and 17 of copending Application No. 10/090,460. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Conclusion

Allowable Subject Matter

9. Claims 6 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Amendment

10. Applicant's argument filed on August 6, 2004 has been fully considered but they are not deemed to be persuasive. Applicant's arguments directed to the teaching of Cook et al fails to "temporarily interrupting the at least one activity relates to the temporary displacement of the activity with the educational services, ***followed by the reengagement of that previous and wholly different activity***". Applicant is reading the limitation into the claim which is just not

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there. It is noted that the specification is not the measure of the invention. Therefore, limitations contained therein cannot be read into the claims for the purpose of avoiding the prior art. *In re Sporck*, 55 CCPA 743, 386 F.2d 924, 155 USPQ 687 (1968). Hence, applicant's argument is not deemed to be persuasive and the rejections are proper and stand.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe H. Cheng whose telephone number is (703)308-2667. The examiner can normally be reached on Tue.- Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (703)308-2064. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joe H. Cheng
Primary Examiner
Art Unit 3713

Joe H. Cheng
January 10, 2005

